



*LPW*

PATENT  
Customer No. 22,852  
Attorney Docket No. 5587.0011-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
)  
Martin J. Polsenski et al. ) Group Art Unit: 1651  
)  
Serial No.: 10/617,177 ) Examiner: K.C. Srivastava  
)  
Filed: July 11, 2003 )  
) Confirmation No.: 3038  
For: COATINGS WITH ENHANCED )  
MICROBIAL PERFORMANCE )

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

In a restriction requirement dated December 16, 2004, the Examiner required restriction under 35 U.S.C. § 121 between

- Group I. Claims 1-25 drawn to a composition, classified under Class 424, Subclass 93.1 for example.
- Group II. Claims 26-30 drawn to a method to reduce microorganism, classified under Class 435, Subclass 74 for example.

Applicants provisionally elect, with traverse, to prosecute Group I, claims 1-25 drawn to an article.

Applicants respectfully traverse the restriction. According to MPEP § 803, there are two requirements that must be met before a proper restriction requirement may be made: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. Applicants

respectfully submit that the Office has failed to establish the second requirement set forth in MPEP § 803.

A proper search for the subject matter of Group I would at least overlap the search for the subject matter of Group II, and would not pose a serious burden on the Examiner to search and examine both groups together. Therefore, Applicants request reconsideration of the Restriction Requirement and the examination of Groups I and II together in the instant application.

In the event the Office denies favorable reconsideration of the Restriction Requirement, Applicants expect the Office to rejoin the method of making claims of Group II upon the indication of allowable subject matter of the article claims of Group I. In accordance with the rejoinder procedure set out in M.P.E.P. §821.04, which establishes guidelines for treating restriction between product and process claims in light of *In re Ochiai*, 71 F.3d 1565, 37 USPQ 2d 1127 (Fed. Cir. 1995), if the claims directed to a product are found allowable, the withdrawn process claims, which include all the limitations of the product claims, should be rejoined.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: January 6, 2005

By: Charles E. Van Horn  
Charles E. Van Horn  
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